

REMARKS

Claims 19-23, 25, 31, and 37-49 are pending in the application after entry of this amendment. Claims 19-36 were previously variously rejected under 35 U.S.C. § 103 in view of Perkowski (U.S. Patent No. 5,950,173).

Independent claims 19, 25, and 31 have been amended to more particularly point out the invention.

Newly added claims 37-43 are similar in some respects to claims previously presented in U.S. Patent Application Serial No. 09/550,703 (now abandoned). The claims in that application were variously rejected under 35 U.S.C. § 103 as obvious over Sheflott et al. ((U.S. Patent No. 5,802,493) in view of Tibbetts (U.S. Patent No. 6,158,044) and Flores et al. (U.S. Patent No. 6,073,109)

Newly added claims 44-49 are similar in some respects to claims previously presented in U.S. Patent Application Serial No. 09/550,414 (now abandoned). The claims in that application were various rejected under 35 U.S.C. § 103 as obvious over Sheflott in view of Tibbetts and Flores, all of which have been made of record in this application.

For at least the reasons stated below, Applicant urges that all claims currently presented are now in condition for allowance.

A. The Present Invention

In one aspect, the present invention provides a facility for bringing together parties on one hand who desire contract manufacturing services, and manufacturers on the other hand. A database contains information about a plurality of potential providers and the various services they offer. Users can query the database to obtain information regarding the various providers, and select a desired provider based at least in part on the information contained within the database regarding the services offered by that provider. The invention also facilitates the contracting for services, the monitoring of status and the progress of the manufacturing process contracted for, and the querying of various technical service providers within the selected provider such as engineers and chemists, regarding the services. The invention is particularly useful in allowing companies to search among various fine chemical contract manufacturers based on the services they provide and other salient criteria, and select a particular manufacturer to manufacture chemicals for them.

B. The Prior Art

(i) Perkowski (U.S. Patent No. 5,950,173)

Perkowski is nothing like the present invention. Perkowski discloses a "virtual salesman kiosk" (see figure on face page of patent) in which a user scans the Universal Product Code (UPC) on a consumer-product, and obtains information regarding the product, the company which manufactures that product, the retailers which sell that product, prices offered by the various sellers, consumer reviews of the product, and URL links to sites where additional information regarding the product or the manufacturer can be found. See Abstract.

It is important to note that Perkowski is directed to providing information regarding commercially available consumer-products, where the consumer-product information in the database is retrieved and accessed based upon the UPC label printed on the consumer-product. See Abstract. Perkowski is a "consumer-product information collection, transmission and delivery system." Col. 4 lines 66-67.

It is also important to note what Perkowski does not disclose. Perkowski has nothing to do with selecting a particular manufacturer from among a plurality of manufacturers, so that the user can contract with the manufacture to manufacture goods or to perform technical services.

Perkowski has nothing to do with proposals or requests for proposals, especially requests for manufacturing proposals or technical service proposals.

Perkowski has nothing to do with managing assets in a network-based supply chain.

Perkowski has nothing to do with tracking status of anything, especially tracking of status of manufacturing processes.

(ii) Sheflott, et al. (U.S. Patent No. 5,802,493)

Sheflott relates to "a method and apparatus for generating responses to questionnaires." See "Technical Field." Sheflott purports to disclose a system for automatically generating answers to questionnaires, using a database populated by question-and-answer pairs. The system receives questions such as the questions asked of a medical services provider when an employer is seeking to find a medical insurance provider, and searches the database to see whether a similar question has been asked. If yes, then the system prints out the question-and-answer pair so that the user can determine whether the "canned" answer provided comes close enough to answering the question asked and therefore can be used in responding to the questionnaire, or whether manual amending of the answer is necessary. See, e.g., Abstract; col. 5, lines 19-36.

Sheflott does not assist in selecting from among a plurality of manufacturing or service providers, information regarding whom is stored in a database. Rather, Sheflott only assists in determining whether a company should bid for a particular health insurance proposal. For example, Sheflott purports to help a company "see whether or not the prospect company [a company which is seeking health insurance for its employees] and its employees geographic locations are an appropriate match for the doctors and other health care providers that are associated with the proposed [health insurance coverage] plan" using a ZIP code matching system to compare employees' ZIP codes to doctors' ZIP codes. Col. 6, lines 57-66. If the match is not a good match, then it is not appropriate for the insurance company to compete for that company's business. Col. 6, line 66 – col. 7, line 3. In sum, Sheflott only teaches seeing whether or not it is worth bidding for a health insurance contract. This has nothing to do with selecting a particular manufacturer or service provider from among a plurality of vendors, to which the present invention is directed.

Furthermore, one seeking a solution to the problem of selecting a particular contract manufacturer from among the universe of possible contract manufacturers, to which the present invention is directed, would not turn for a solution to systems of generating answers to health insurance questionnaires.

However, in order to more clearly distinguish over Sheflott the claims have generally been amended to recite that the system facilitates a user to select a *particular* provider from among a *plurality* of providers.

(iii) Tibbetts (U.S. Patent No. 6,158,044)

The Examiner in this case was also the Examiner in U.S. Patent Application No. 09/550,414 (now abandoned). The Examiner cited Tibbetts, and particularly Figures 5 and 7, as teaching a request for proposal mechanism.

Tibbetts is totally irrelevant to the present invention. Tibbetts purports to introduce a software notion of a "proposal" object, which is a software object that de-couples the front-end of a computer (e.g., mouse click, keystroke) from the back end (e.g., an action on a memory such as file read action or file write action). See, e.g., Figs. 3, 4, and 7; col. 1 line 60 – col. 2, line 11. As explained by Tibbetts:

A Proposal is accessed via one or more User Interfaces (UI). This breaks the close coupling between the front-end and the back-end, thereby allowing the user to add a Web interface or Graphical User Interface (GUI) or other kind of front-end without having to rewrite the back-end [software] application.

Abstract. Although a software programmer might turn to Tibbetts for Tibbetts' teaching of a way to de-couple the front-end and back-end of a computer, Tibbetts has nothing to do with a proposal for an economic transaction, or a request for a proposal for an economic transaction, to which certain recited aspects of the present invention are directed. Therefore, the claims have generally been amended to clarify that the invention includes a mechanism for a request for an economic transaction proposal, thus clearly distinguishing over Tibbetts' software construct and rendering Tibbetts irrelevant and inapplicable to the invention as now claimed.

C. 35 U.S.C. § 103 Rejections

All previously presented claims 19-36 were rejected under 35 U.S.C. § 103 in view of Perkowski (U.S. Patent No. 5,950,173). The cited reference is inapplicable and fails to teach or suggest all of Applicant's newly-added claims. MPEP 2143 provides in part, "To establish a prima facie case of obviousness...the prior art reference...must teach or suggest **all** the claim limitations." (emphasis added). Under *In Re Lee*, 61 USPQ2d 1430, there must be evidence of the showing of a suggestion, teaching or motivation to combine the state of the art including what might be considered basic knowledge or common sense to combine or modify references. No such suggestion is present here in any of the references cited by the Examiner. Applicant therefore respectfully requests that the Examiner's § 103 rejections be withdrawn.

Applicant's invention provides, among other features, a way to bring together in an on-line manufacturing framework both manufacturing service providers and buyers desiring to contract with those manufacturers.

Claim 19

Claim 19 as currently presented recites:

providing a database including a request for proposal mechanism and a plurality of service provider data structures and a plurality of manufacturer data structures, wherein said request for proposal is a request for an economic transaction proposal, wherein each service provider data structure includes a description of service provided by a particular service provider, and wherein each manufacturer data structure includes a description of offerings of a particular manufacturer;

identifying a particular data structure based on a request for an economic transaction proposal from a user utilizing the request for proposal mechanism, wherein the user may be a service provider or a manufacturer (new limitations are underlined).

The Examiner asserted that virtually all of this subject matter is disclosed in Perkowski. For example, the Examiner contends that:

Perkowski discloses providing a database (see fig. 1 and fig. 2A1, a central UPC/URL database, item 9, col. 11, lines 35-40) including a request for proposal mechanism and a plurality of service provider data structures and a plurality of manufacturer data structures (see fig. 2, item 10, telecommunications network for Internet service Providers, col. 11, lines 45-55; and Internet product information servers, col. 11, lines 60-65) wherein each service provider data structures includes a description of service provided by a particular service provider, and wherein each manufacturer data structure includes a description of offerings of a particular manufacturer (see UPN data structure: col. 9, lines 25-48 and lines 60-67; also col. 11, lines 60-65; col. 12, lines 15-20); identifying a particular data structure based on a request for proposal from a user utilizing the request for proposal mechanism; wherein the user may be a service provider or a manufacturer (col. 4, lines 22-31; Internet shopper project). . .

(Office Action, page 3). Applicant respectfully disagrees. The cited reference and passages do not support the Examiner's contention. As discussed above, Perkowski discloses a "virtual salesman kiosk" (see figure on face page of patent) in which a user scans the Universal Product Code (UPC) on a consumer-product, and obtains information regarding the product, the company which manufactures that product, the retailers which sell that product, prices offered by the various sellers, consumer reviews of the product, and URL links to sites where additional information regarding the product or the manufacturer can be found. See Abstract.

It is important to note that Perkowski is directed to providing information regarding commercially available consumer-products, where the consumer-product information in the database is retrieved and accessed based upon the UPC label printed on the consumer-product. See Abstract. Perkowski is a "consumer-product information collection, transmission and delivery system." Col. 4 lines 66-67.

Perkowski has nothing to do with selecting a particular manufacturer from among a plurality of manufacturers, so that the user can contract with the manufacture to manufacture goods or to perform technical services.

As quoted above, the Examiner contends that Perkowski discloses a request for proposal mechanism at fig. 2, item 10, telecommunications network for Internet service Providers, col. 11, lines 45-55. That is not true. The undersigned has studied the cited passage and the cited reference, and searched an electronic version of the reference; the reference simply does not mention or refer to a request for proposal anywhere.

As quoted above, the Examiner contends that Perkowski discloses at col. 4, lines 22-31 identifying a particular data structure based on a request for proposal from a user utilizing a request for proposal mechanism. That is not true. The undersigned has studied the cited passage and the entire reference, and can find no reference to identifying a data structure based on a request from a user utilizing a request for proposal mechanism.

Although in the related applications mentioned above the Examiner contends that Tibbetts provides a request for proposal mechanism, as discussed more fully above Tibbetts' "proposal" is merely a software construct design to couple a computer front-end (e.g., keystrokes) from the back end (e.g., file read and write operations). Applicant has amended claim 19 to recite that the request for proposal in the claimed invention is a "request for proposal is a request for an economic transaction proposal." Thus, even if one were to combine Tibbetts' software objects with the other art of record, the reference would not disclose or suggested the invention as now claimed. Additionally, one searching for ways to facilitate manufacturing contracts would not look to computer programming references that teach how to de-couple computer inputs (e.g., keystrokes) from back-end operations (e.g., file operations).

Accordingly, claim 19 as written defines a novel and nonobvious mechanism for facilitating contract manufacturing.

Still further, as quoted above the Examiner contends that Perkowski discloses at col. 11, lines 18-32; col. 3, lines 62-67; and col. 4, lines 1-22, the subject matter of "providing maintenance and services of service provider assets and manufacturer assets." This is not true. The undersigned has studied the cited passages and the Perkowski reference. The claimed subject matter is nowhere disclosed in the reference. Nor does the reference remotely suggest such a thing. The reference discloses a kiosk in which a consumer scans the UPC on a consumer-product, and obtains static information about the consumer-

product. Perkowski's kiosk is not remotely related to maintenance and service of service provider assets and manufacturer assets as recited.

Claim 20

The Examiner contends that Perkowski discloses at col. 11, lines 34-65, "the steps of tracking a status of manufacturing processes performed by the identified service provider." Office Action at 4. This is not true. At most, Perkowski discloses that his "virtual salesman kiosk" allows a consumer to view availability and booking dates of a consumer-product. Col. 11, line 48. Perkowski nowhere mentions tracking of the various processes involved in manufacturing any kind of product. The undersigned has searched the reference and has found no mention or suggestion of such subject matter.

Accordingly, claim 20 as written is novel and nonobvious over Perkowski.

Claim 21

The Examiner contends that Perkowski discloses at col. 11, lines 34-65, the steps of "allowing the user to inquiry service engineers and service chemists." Office Action at 4. This is not true. The cited passage in no way mentions engineers, chemists, or anybody of the sort. The undersigned has searched the reference and has found no mention or suggestion of such subject matter.

Accordingly, claim 21 as written is novel and nonobvious over Perkowski.

Claim 25

As the Examiner has pointed out, Claim 25 is similar to Claim 19. Claim 25 is therefore novel and nonobvious over Perkowski for at least the reasons stated with respect to Claim 19.

Claim 37

Claim 37 is directed to a method of allowing a user to view information in a database concerning services provided by various service providers, and choosing the service provider based upon that information.

In a related application (serial no. 09/550,703, now abandoned) the Examiner rejected a similar claim as obvious over Sheflott in view of Tibbetts and Flores. The Examiner stated, for example, that Sheflott Disclosed at col. 6, lines 52-62 "a method for providing a contract framework comprising the steps of matching a user to a service

provider utilizing a database having information on service providers." Applicant respectfully disagrees.

Sheflott is inapplicable and is nothing like the claimed invention. As discussed more fully above, Sheflott merely discloses a software program to help generated answers to questionnaires, by matching questions asked with the nearest "canned" question-answer pair in a database of question-answer pairs. The questions are prepared by a company seeking health insurance services, and the company which operates the database is a single company which must decide whether to bid for the health insurance contract and how to answer the questions asked. Sheflott has nothing to do with helping a person identify a most-desired manufacturer from among a number of possible manufacturers.

Applicant has added into claim 37 the subject matter that the method includes "using a database to match a user to a service provider selected from among said plurality of service providers based on services provided by the selected service provider." That claim now clearly distinguishes over Sheflott and any of the prior art cited in this application or the related applications.

For at least these reasons, claim 37 and claims 38-43 depending therefrom patentably distinguish over the prior art.

Claim 44

Claim 44 is generally directed to matching contract manufacturers with persons who desire the manufacturing process design services available. In a related application, serial no. 09/550414 (now abandoned), the Examiner rejected a similar claim as obvious over Sheflott in view of Tibbetts and Flores.

The preamble of claim 44 recites that the method is used "in a contract manufacturing framework." The claim recites that the information in the database includes "process design services" and that the method identifies a particular service provider from among a plurality of service provider data structures based upon the information in the database.

None of the references cited have anything to do with a contract manufacturing framework, or selecting service providers based upon services offered and especially based on process design services offered as recited. Sheflott, for example, relates only to a method whereby one entity can answer questionnaires put to it relating to health services. Tibbetts merely relates to a new software construct which he calls a "proposal" by which the front-end of a computer (e.g., keystrokes, mouse clicks) is de-coupled from back-end operations (e.g., file read and write operations). Flores relates to a computer program by

which a user can schedule tasks for completion, receive reminders, see how his tasks fit in to the overall project, and similar functions. See Abstract.

Accordingly, claim 44 is novel and nonobvious over the cited references which are inapplicable.

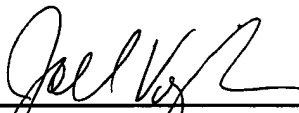
Claims 45-49, which depend from claim 44, are allowable for at least the reasons stated with respect to claim 44.

B. Conclusion

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 310-319-5459 x100. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (reference 60021-358201).

Dated: May 12, 2003

Respectfully submitted,



JOEL D. VOELZKE
REGISTRATION NO. 37,957
Customer No. 29838

OPPENHEIMER WOLFF & DONNELLY LLP

Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402

Telephone: 612.607.7000
Facsimile: 612.607.7100